

REMARKS

The Final Office Action of December 19, 2002 rejected claims 1, 3, 5-12, 14 and 16 under Section 102(e) as anticipated by Shiota et al. (USPN 6,324,521). Claim 13 was rejected as unpatentable over Shiota, while Claims 2, 4, 15 and 17-20 were rejected under Section 103(a) as unpatentable over Shiota and Tackbary (USPN 6,092,054). New claim 21 was rejected under Section 112 as unsupported by the specification.

Applicant has carefully reviewed Shiota and Tackbary, and respectfully traverses the Section 102 and 103 Rejections, as discussed below.

The Section 112 Rejection

Claim 21 has been amended and it is requested that the Section 112 Rejection be withdrawn.

The Section 102 Rejections

Before we address the specifics of the Section 102 Rejection, a brief review of one exemplary embodiment is helpful. The exemplary embodiment provides ease of use to the user who orders a plurality of cards for different recipients. The cards may or may not be customized (for example, customized border or customized cropping, among others). This capability is useful during the winter holiday season, for example, to allow users to order 50 to 100 Christmas cards online for their family members and friends, who may be residing at different locations. Running through an order process one at a time for each of the 50-100 Christmas cards is time consuming. This inconvenience would deter many users from using the customized features for online card ordering.

Turning now to the Section 102 Rejections, according to MPEP 2131, to anticipate a claim, the reference must teach every element of the claim. In particular, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

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Applicants do not find that the Shiota reference teaches every element set forth in claim 1 of the instant application. For example, among other differences, Shiota does not show the specifics of a single order that specifies multiple recipients.

The Final Office Action notes that Shiota teaches a computer implemented method of distributing cards to a plurality of recipients. Specifically, pages 7-8 of the Office Action asserted that

col. 11, line 38 – Col. 12, line 24 discloses that there are a plurality of recipients (customer and his/her friend). Also see Fig. 1 (6-PC correspond to a plurality of recipients).

For each of the plurality of recipients specified in the received card order, printing at least one card having at least one uploaded image from the recipient's image set and distributing the printed cards having the recipient's uploaded images to their respective associated recipients (col. 11, lines 38-col. 12, line 24. Customer and his friend are the plurality of recipients and prints (which could be photograph/postcards/picture postcards as disclosed in col. 3, lines 31-35 and col. 4, lines 28-32) with uploaded images are distributed to customer and to the customer's friend).

While Shiota does show a plurality of recipients, Shiota does not show claim 1's receiving a card order specifying a plurality of recipients. Although Shiota's Fig. 1 shows a plurality of PCs, there is no showing that each PC can issue a single card order that specifies a plurality of recipients. Fig. 2 of Shiota shows that each order relates to one recipient with one recipient address. Thus, in Shiota, a user places multiple orders, each time the user can specify a different single recipient. Fig. 3 of Shiota shows the resulting order file with two recipients when the user places the order twice.

Shiota also discusses an example showing that multiple prints may be ordered. However, the discussion below is silent on whether the customer can order for all recipients at once or one recipient at a time:

After the customer returns, he/she accesses the center server 12 from the personal computer 6 at home and orders extra prints of these pictures (105). At this time, for example, among the pictures whose first prints were ordered from the minilab 3a, an extra print of a picture a is ordered for the customer while a picture b is for the friend, and among the pictures whose first prints were ordered from the minilab 3b, an extra print of a picture c is ordered for the customer.

As for the pictures for the customer, the minilab 3a is specified as the laboratory at which the prints are received. As for the picture for the friend, mailing may be specified as the method to receive the print. However, in the case of air mail, it takes more than one day for the print to reach the friend. On the other hand, if an order is carried out with the friend being specified as the recipient and the laboratory 3b as the laboratory at which the print is received, the print can reach the friend on the day of the order at the earliest.

Because Shiota's Fig. 2 shows one recipient designation at a time, the only logical conclusion one can reach is that at one sitting, the user must individually enter a separate order for each recipient. The Shiota ordering process is not practicable during card giving seasons such as Christmas where an orderer may want to send hundreds of cards to hundreds of recipients.

In one embodiment of the system, the user can specify in a single order a plurality of recipients rather than specifying multiple orders multiple times each specifying one recipient at a time. As discussed on pages 11-12 of the instant specification, the invention is advantageous over Shiota with one or more of the following advantages:

The systems and techniques described here provide intuitive and convenient mechanisms that allow a user to order prints of images and have the prints distributed to multiple recipients at different locations with a minimum of time, trouble and expense on the part of the ordering user. For example, in a single ordering sequence, a user can specify a set of one or more prints and have them distributed to multiple different recipients. As a result, the user need not reenter redundant information – for example, identifying the images to be printed, supplying payment information, and the like – as otherwise would be required if the print order was limited to a single shipping destination. Moreover, by allowing a user to specify multiple recipients within a single print order, the user is not subjected to a minimum dollar amount for each of several different orders. Rather, because multiple recipients are allowed, the user is better able to satisfy

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the minimum dollar amount without being forced to order more prints than otherwise would be desired.

In addition, because an order can designate multiple recipients, the user need not incur multiple charges on a credit card or other financial instrument when ordering prints for multiple recipients. Furthermore, by allowing the user to specify different print parameters (e.g., size, number of copies, finish) for each of the individual recipients, flexibility and convenience in the print ordering process are enhanced.

Moreover, users can distribute copies of prints to multiple recipients without having to incur the effort and expense involved in receiving print copies from a photofinisher, sorting the prints into sets according to destinations, putting the prints in protective envelopes, and then re-mailing the sets of prints to their respective recipients. As a result, sets of prints can be distributed to multiple destinations more quickly and with less expense and effort.

In addition, by employing a non-linear workflow model certain benefits and efficiencies are realized. More particularly, by taking a single multiple-recipient order, breaking it down into sub-orders corresponding to a single recipient, selectively instantiating and re-organizing multiple instances of designated images to build each sub-order, and then printing each sub-order as a separate run of prints for the associated recipient, a single print order (transaction sequence) can be used to order prints to be generated and distributed to multiple recipients. Moreover, such a non-linear workflow tends to increase the efficiency and/or speed of the print generation and distribution tasks dramatically.

Further, according to MPEP 2131, "the elements must be arranged as required by the claim". *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). In this case, Shiota does not show the user-uploaded aspect present in claim 5, now moved up to claims 1 and 21 to clarify the invention. This is another reason for traversing the Section 102 Rejection.

In Shiota, the user brings a roll of film to a processing lab for scanning. The lab has a laboratory server installed in a laboratory having a picture printer, and a center server installed in a service center which receives a printing service order via the network. However, Shiota does not show that a user directly upload images to a server. Hence, Shiota does not have the user-uploaded aspect as claimed. To compare, Claim 1 recites:

receiving a card order specifying a plurality of recipients and, for each specified recipient, a set of one or more user-uploaded images associated with that recipient;

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and

distributing the printed cards having the recipients' uploaded images to their respective associated recipients.

Hence, the user-uploaded element is missing in Shiota, and this is another basis for traversing the Section 102 Rejections.

Since a number of elements are missing in Shiota, Shiota cannot anticipate independent claims 1 and 21 or those dependent therefrom. For this reason, Shiota cannot anticipate claim 3. Additionally, claim 4 cannot be anticipated since Shiota does not show the specifics of print parameters that include one or more of print size, number of copies, print finish, and/or a textual message for the printed cards. With regard to claims 5-6, Shiota shows that a print service uploads images scanned from film. However, there is no teaching in Shiota that a user directly uploads the images. Claims 7-8 are allowable in that they depend from allowable claim 1. With respect to claim 9, Shiota does not show the web front-end for a user and thus claim 9 is allowable over Shiota. With regards to claims 11-12, Shiota is silent on whether the card order comprises a single transaction sequence. Shiota also does not show a single transaction sequence terminated by a click of a "card order" button (see discussion of single order with multiple recipients above).

In sum, since one or more elements are missing in Shiota, Shiota cannot anticipate claims 1 and 21 and those dependent therefrom. Withdrawal of the Section 102 rejection is respectfully requested.

The Section 103 Rejections

Claim 13 was rejected as unpatentable over Shiota, while Claims 2, 4, 15 and 17-20 were rejected under Section 103(a) as unpatentable over Shiota and Tackbary (USPN 6,092,054).

Here, neither Shiota nor Tackbary shows the claimed element of receiving a card order specifying a plurality of recipients and, for each specified recipient, a set of one or more user-uploaded images associated with that recipient; for each of the plurality of recipients specified in the received card order, printing at least one card having at least one uploaded image from the recipient's image set; and distributing the printed cards having the recipients' uploaded images to their respective associated recipients.

Hence, Shiota and Tackbary, singly or in combination, cannot render claims 2, 4, 13, 15 and 17-20 obvious. Withdrawal of the Section 103 rejection is respectfully requested.

Conclusion

Applicants respectfully submit that all claims are in condition for allowance. Withdrawal of the objections and rejections is respectfully requested.

Authorization to charge Deposit Account 501861 is granted.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



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MARKED UP VERSION OF THE CLAIMS SHOWING CHANGES

1. A computer-implemented method of distributing cards to a plurality of recipients, the method comprising:

receiving a card order specifying a plurality of recipients and, for each specified recipient, a set of one or more user-uploaded images associated with that recipient;

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients.

21. (New) A computer-implemented method of distributing cards to a plurality of recipients, the method comprising:

receiving a card order from an orderer, such order specifying a plurality of recipients [other than the orderer] where at least one of the specified recipients is different from the orderer and, for each specified recipient, a set of one or more user-uploaded images associated with that recipient;

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set; and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients.